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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,915	06/21/2006	Roland Huttinger	P40110US	5072
83956 7590 03/08/2010 Viering, Jentschura & Partner - OSR 3770 Highland Ave. Suite 203 Manhattan Beach, CA 90266				
EXAMINER PERRY, ANTHONY T				
ART UNIT 2879		PAPER NUMBER		
NOTIFICATION DATE 03/08/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/583,915

Applicant(s)

HUTTINGER ET AL.

Examiner

ANTHONY T. PERRY

Art Unit

2879

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8-11, 13, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (US 5,327,045).

Regarding claims 1 and 3, Fox discloses an electrode for discharge lamps made from a high-melting, electrically conductive material comprising a pin which defines a longitudinal axis and wherein the pin comprises a shaft (not labeled, but shown in Fig. 1) and a head part (70 in Fig. 5), wherein the head part (70) has a diameter D2 which extends beyond that of the shaft, wherein at least one hole (72) is arranged in the head part of the pin at an angle of 60 to 90 degrees with respect to the longitudinal axis (for example, see the abstract and Figs. 1 and 5).

Fox teaches the pin being formed of separate head and pin parts, and does not specifically teach the pin being continuous (integral). However, it has been held that forming in one piece an article that has formerly been formed in two pieces and put together involves only routine skill in the art. It is noted that the applicant's specific limitation of the electrode being a continuous pin (integral head and shaft parts), does not solve any of the stated problems or yield any unexpected result that is not within the scope of the teachings applied. Therefore it is considered to be a matter of choice, which a person of ordinary skill in the art would have found obvious to select an electrode having an integral head and shaft part or one that is made of two separate parts connected together.

Regarding claim 2, Fox does not specifically disclose an embodiment wherein the shaft and the head part have a uniform, predetermined diameter. However, it is noted that such configurations of lamp discharge electrodes are known in the art. Also, it is noted that the applicant's specific limitation of the shaft and the head part does not solve any of the stated problems or yield any unexpected result that is not within the scope of the teachings applied. Therefore it is considered to be a matter of choice, which a person of ordinary skill in the art would have found obvious to select any configuration (same diameters or a larger diameter for the head of the electrode), based on the constraints of the lamp being manufactured and the desired discharge properties, as long as the electrode head has transverse holes provided therein.

Regarding claim 4, Fox teaches the electrode as claimed in claim 1, wherein the hole (72) is continuous or is in the form of a blind hole (for example, see Fig. 5).

Regarding claim 5, Fox teaches the electrode as claimed in claim 1, but does not recite the head part containing at most three holes. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. Thus, it would have been obvious to one of ordinary skills in the art at the time the invention was made to provide an appropriate number of holes based on the size of the head of the electrode and the strength of the material used for the head of the electrode, since discovering an optimum value of a result variable is considered within the skills of the art.

Regarding claim 8, Fox teaches the electrode as claimed in claim 1, wherein the hole is linear (for example, see Fig. 5).

Regarding claim 9, Fox teaches the electrode as claimed in claim 1, wherein the plurality of holes (20,20') lie in one plane (see Fig. 5).

Regarding claim 10, Fox teaches the electrode as claimed in claim 9, wherein the plurality of holes are connected to one another (see Fig. 5).

Regarding claim 11, Fox teaches the electrode as claimed in claim 4, wherein the hole is a blind hole and wherein each blind hole has a depth of at least 50% of the diameter of the head part (see Fig. 5).

Regarding claim 13, Fox teaches the electrode as claimed in claim 1, wherein the distance between the center of the hole (20) and the tip is denoted by A, the ratio A to the diameter of head part is within a range between 1 and 6 (for example, see Fig. 5).

Regarding claim 14, Fox teaches the electrode as claimed in claim 1, wherein the ratio between the diameter of the hole and the diameter of the head part is between 0.05 and 0.3 (see col. 3, lines 51 – col. 4, line 3).

Regarding claim 15, Fox teaches a lamp having at least one electrode as claimed in claim 1, wherein the discharge vessel is made of glass or ceramic. Fox does not specifically recite the fill material of the lamp. However, it is well known in the art to use mercury and/or sodium as the fill material in discharge lamps. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Thus, it would have been obvious to one having ordinary skills in the art at the time the invention was made to have used mercury and/or sodium as the gas fill of the discharge lamp taught by Fox, since the selection of known materials for a known purpose is within the skill of the art.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (US 5,327,045) in view of Neiger et al. (US 4,937,496).

Regarding claim 12, Fox teaches the electrode as claimed in claim 1, but does not specifically recite that the tip of the head part is rounded off.

However, Neiger et al. teach an electrode of a discharge lamp having the tip of the head part is rounded off (for example, see col. 2, line 65 – col. 3, line 1). Neiger teaches that by rounding off the tip portion of the head of the electrode, it prevents disintegration and melting of the electrode tip. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to round off the tip of the electrode taught by Eggers in order to prevent disintegration and melting of the tip of the electrode, and thereby increasing the lifetime of the lamp.

Claims 1-7, 9-13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Bie et al. (US 4,117,367).

Regarding claims 1 and 3, de Bie discloses an electrode for discharge lamps made from a high-melting, electrically conductive material comprising a pin which defines a longitudinal axis and wherein the pin comprises a shaft (33) and a head part (21), wherein the head part (21) has a diameter D2 which extends beyond that of the shaft (33), wherein at least one hole (72) is arranged in the head part of the pin at an angle of 60 to 90 degrees with respect to the longitudinal axis (for example, see Figs. 2 and 3).

De Bie teaches the pin being formed of separate head and pin parts, and does not specifically teach the pin being continuous (integral). However, it has been held that forming in one piece an article that has formerly been formed in two pieces and put together involves only routine skill in the art. It is noted that the applicant's specific limitation of the electrode being a continuous pin (integral head and shaft parts), does not solve any of the stated problems or yield any unexpected result that is not within the scope of the teachings applied. Therefore it is

considered to be a matter of choice, which a person of ordinary skill in the art would have found obvious to select an electrode having an integral head and shaft part or one that is made of two separate parts connected together.

Regarding claim 2, de Bie does not specifically disclose an embodiment wherein the shaft and the head part have a uniform, predetermined diameter. However, it is noted that such configurations of lamp discharge electrodes are known in the art. Also, it is noted that the applicant's specific limitation of the shaft and the head part does not solve any of the stated problems or yield any unexpected result that is not within the scope of the teachings applied. Therefore it is considered to be a matter of choice, which a person of ordinary skill in the art would have found obvious to select any configuration (same diameters or a larger diameter for the head of the electrode), based on the constraints of the lamp being manufactured and the desired discharge properties, as long as the electrode head has transverse holes provided therein.

Regarding claim 4, de Bie teaches the electrode as claimed in claim 1, wherein the hole is continuous or is in the form of a blind hole (for example, see Fig. 2).

Regarding claim 5, de Bie teaches the electrode as claimed in claim 1, but does not recite the head part containing at most three holes. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. Thus, it would have been obvious to one of ordinary skills in the art at the time the invention was made to provide an appropriate number of holes based on the size of the head of the electrode and the strength of the material used for the head of the electrode, since discovering an optimum value of a result variable is considered within the skills of the art.

Regarding claim 6, de Bie teaches the electrode as claimed in claim 1, wherein the diameter of the hole varies, the hole having a maximum diameter B (for example, see Fig. 2).

Regarding claim 7, de Bic teaches the electrode as claimed in claim 6, wherein the maximum diameter is in each case approximately the same size in the case of a plurality of holes (see Fig. 2).

Regarding claim 9, de Bic teaches the electrode as claimed in claim 1, wherein the plurality of holes lie in one plane (see Fig. 2).

Regarding claim 10, de Bic teaches the electrode as claimed in claim 9, wherein the plurality of holes are connected to one another (see Fig. 2).

Regarding claim 11, de Bic teaches the electrode as claimed in claim 4, wherein the hole is a blind hole and wherein each blind hole has a depth of at least 50% of the diameter of the head part (see Fig. 2).

Regarding claim 12, de Bic teaches the electrode as claimed in claim 1, wherein the continuous pin comprises a tip and wherein the tip (22) of the head part is rounded off (see Fig. 2).

Regarding claim 13, de Bic teaches the electrode as claimed in claim 1, wherein the distance between the center of the hole and the tip is denoted by A, the ratio A to the diameter of head part is within a range between 1 and 6 (for example, see Fig. 2).

Regarding claim 15, de Bic teaches a lamp having at least one electrode as claimed in claim 1, wherein the discharge vessel is made of glass or ceramic and contains metal vapor (for example, see col. 1, lines 13-15).

Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers (US 6,437,509) in view of Makoto (JP 11-123577).

Regarding claim 16, Eggers teaches a method for producing an electrode, in which the electrode has a pin-shaped head part having a longitudinal axis, wherein a hole (20) is produced essentially transversely with respect to the longitudinal axis using a laser (for example, see col. 1, lines 44-61 and Fig. 9). Eggers does not specifically recite that the hole is made by short laser pulses of a maximum of 10 microseconds in duration.

However, it has been held to be within the general skill of a worker in the art to select a known method on the basis of its suitability for the intended use as a matter of obvious design choice. Furthermore, Makoto teaches a method of forming holes into an article, that uses short laser pulses of a maximum of 10 microseconds in duration (for example, see the abstract). It would have been obvious to one having ordinary skills in the art at the time the invention was made to have looked to the Makoto reference for guidance in operating the laser to form the holes, since Eggers remains silent about the specifics on how the laser is used to form the holes.

Regarding claim 17, Makoto teaches the the laser beam is focused (for example, see abstract and Fig. 1).

Same reasoning for combination, above, applies.

Regarding claim 18, Makoto teaches that the rate of repetition of the pulses is at least 1 kHz (for example, see the abstract).

Same reasoning for combination, above, applies.

Regarding claim 19, Eggers and Makoto do not specifically recite that that the energy density of the focused laser beam is above the energy density required for sublimation of the material of the electrode. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have ensured that the energy density of the focused laser

beam is above the energy density required for sublimation of the material of the electrode.

Otherwise, it would not be possible to form the holes with such accuracy.

Response to Arguments

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

The Examiner disagrees with the Applicant's argument that the head part of the Eggers reference is not "pin-shaped".

Conclusion

Applicant's amendments submitted 6/25/09 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Anthony Perry* whose telephone number is (571) 272-2459. The

examiner can normally be reached between the hours of 9:00AM to 5:30PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel, can be reached on (571) 272-2457. **The fax phone number for this Group is (571) 273-8300.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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